

REMARKS/ARGUMENTS

Favorable reconsideration of this application is respectfully requested.

Claims 7-22 are pending in this application. Claims 1-6 have been canceled without prejudice or disclaimer. Claims 15 and 16 have been amended in accordance with the objection made as to Claim 15 without the introduction of any new matter.

The outstanding Office Action includes an objection to Claim 15, a rejection of Claims 9, 10, and 21 under the second paragraph of 35 U.S.C. §112, a rejection of Claims 13-16 under §103(a) as unpatentable over Hsiao et al. (U.S. Patent No. 6,266,784, Hsiao) in view of Kazu (JP 06-153140)¹, a rejection of Claims 12, 17, 18, and 22 under §103(a) as unpatentable over Tarabella (U.S. Patent No. 5,796,945) in view of Kazu, a rejection of Claim 19 under §103(a) as unpatentable over Tarabella in view of Kazu in further view of Nathan (U.S. Patent No. 6,240,550), a rejection of Claims 20 and 21 under §103(a) as unpatentable over Tarabella in view of Kazu in further view of Tatematsu JP 04-240604), and a rejection of Claims 7-11 under §103(a) as unpatentable over Tarabella in view of Kazu in further view of Curtis (U.S. Patent No. 6,278,992).

It is believed that the objection to the Claim 15 should be withdrawn in view of the presentation of the modified Claim 15. In addition, a corresponding change was made to Claim 16. As these changes were made responsive to the outstanding objection, entry thereof is believed to be in order.

With further regard to the rejection of Claims 9, 10, and 21 under the second paragraph of 35 U.S.C. §112, the outstanding Action first makes no attempt to explain what

1. Incorrectly listed as "04-153140" in the outstanding Action.

is considered to be unclear as to the language of Claim 21. In this regard, Claim 21 ultimately depends back to Claim 17 as it directly depends on Claim 20 that depends on Claim 18 that depends on Claim 17. Claim 17, in pertinent part, recites “modifying the accessible file name to include an indication of the specified update conditions to form a retrieval file name” then “combining the retrieval file name with at least the update data to form a back-up retrieval file” and then “saving the back-up retrieval file in a retrieval storage area.” It is against this background that Claim 21 recites “wherein the saving the back-up retrieval file step includes saving only the portions of the current data that have changed as the update data added to the retrieval file name.” There is no lack of clarity as to the limitations of Claim 21 and withdrawal of this rejection as applied to Claim 21 is clearly in order.

Turning to Claims 9 and 10, the limitations questioned as to “linking” a particular kind of file (audio or image) “to said HTML file as part of the update data” are not limitations reciting that data includes “a process of linking” as erroneously asserted on the bottom of page 2 of the outstanding Action. Accordingly withdrawal of this rejection as applied to Claims 9 and 10 is clearly in order.

With regard to the rejection of Claims 13-16 under §103(a) as unpatentable over Hsiao in view of Kazu, it is noted that this rejection is founded on an improper interpretation of the reasonable teachings and fair suggestions of Hsiao to those of ordinary skill in the art.

Turning to the teachings of col. 4, lines 7-21 and lines 58-62 of Hsiao that are relied upon, it is clear that col. 4, lines 7-21 actually teach backing up client files created and

stored internally by system 15 in a primary storage pool 40 in server 19. While the primary copy of the client file is stored in the primary storage pool 40, there is no teaching or suggestion that the client file being stored replaces any other data, much less updates it in any reasonable manner.

While col. 4, lines 58-62 of Hsiao teach that “new Recovery Plan Files” are periodically created and added to a stack, these files contain information to “recreate server 19 once the needed hardware is in place is in place” and are either printed or placed on removable media and stored at a remote location as taught at col. 4, lines 55-58. Thus, whatever else can be said about the Hsiao “new Recovery Plan Files,” it cannot be said that their creation and storage off line reasonably teaches or suggests the base Claim 13 “data updating step in which data stored in an open storage area allowed to be freely accessed via a network is replaced with update data at a specified time.” Moreover, the teachings of col. 4, line 63- col. 5, line 20 as to the “stanzas” of the Recovery Plan File 83 are very specific as to “site specific instructions 81, server requirement stanzas 82, configuration stanzas 83, and command stanzas 84. Clearly, none of these “stanzas” can be said to reasonably teach or suggest the base Claim 13 “data backing-up step in which a retrieval file name is produced by adding data, which represents a date and time when the updating step is to be performed, to a file name of said update data, said retrieval file name is included with backup data produced from said update data to form a backup retrieval file, and said backup retrieval file is saved in a retrieval storage area.”

Not only does the outstanding Action err in failing to carefully analyze and treat all the limitations of the base Claim 13 “data updating step” and the “data backing-up step,” it

completely ignores the base Claim 13 “retrieving step in which the backup retrieval file having the retrieval file name corresponding to an updating time specified via said network is retrieved from said retrieval storage area, and retrieved backup retrieval file data is transferred via said network to a client which has requested said retrieved backup retrieval file data.”

In this last regard, col. 4, lines 22-54 of Hsiao simply disclose that an additional backup copy of the client file, not a backup copy of any listing in the catalog that was “updated,” and certainly none of the stanzas of the “ Recovery Plan Files” is provided in the storage pool 50 by the manager 30 of server 19. It then adds a listing of this additional backup copy to the catalog list to “update” it by addition, not by replacement of existing data therein. While a cross reference is also added and a further backup to a storage volume is taught, there is still no reasonable teaching or fair suggestion here of data stored in an open area that is replaced with update data at a specified time, as noted above, much less a reasonable teaching or fair suggestion of that backup data produced from replacement update data is stored in a retrieval area.

Moreover, there is no teaching or suggestion that the entirely separate provision of the “Recovery Plan Files” has any thing to do with the backup files on copy storage spool 50 and the outstanding Action errs in suggesting that these entirely separate teachings can be combined without establishing reasonable motivation to do it. See In re Kotzab, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000)

While the test for establishing an implicit teaching, motivation, or suggestion is what the combination of these two statements of [the reference applied] would have suggested to those of ordinary skill in the art, the two statements cannot be viewed in the abstract. Rather, they must be considered in the

context of the teaching of the entire reference. Further, a rejection cannot be predicated on the mere identification in [the reference applied] of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.

Accordingly, even if the artisan had some reasonable basis to attempt to modify Hsiao in view of Kazu, even though this is not established in the outstanding Action, the result would not be the subject matter of base Claim 13 of this group of claims and this rejection of Claims 13-16 is traversed.

Furthermore, the file name suggestion of Kazu relates to providing an original file name, not a backup file name and not something remotely like the stanzas of the Hsiao "new Recovery Plan Files." Thus, there is no logical basis presented in the outstanding Action to apply the Kazu teaching to the stanzas or the backup files of the client files that are stored on server 19 instead of the original client files in primary storage pool 40.

In addition, the further reference in the outstanding Action to col. 5, lines 46-59 and col. 9 lines 5-9 deal with "Recovery Plan File" storage and recovery by target server 90 and are not seen to be reasonably read as a client request for data from the claimed retrieval area as to backup retrieval files having the claimed retrieval names that must include replacement of data times.

In addition to sharing the above noted steps of base Claim 13 that are not reasonably taught or fairly suggested by Hsiao taken alone or together with Kazu in any proper combination, Claims 14-16 add features that are further are not reasonably taught or fairly suggested by Hsiao taken alone or together with Kazu. Thus, the rejection as applied to

Claims 14-16 is traversed for this reason as well.

The rejection of Claims 12, 17, 18, and 22 under §103(a) as unpatentable over Tarabella in view of Kazu, and the rejection of Claim 19 under §103(a) as unpatentable over Tarabella in view of Kazu in further view of Nathan, the rejection of Claims 20 and 21 under §103(a) as unpatentable over Tarabella in view of Kazu in further view of Tatematsu, and the rejection of Claims 7-11 under §103(a) as unpatentable over Tarabella in view of Kazu in further view of Curtis are also traversed.

Base Claim 17 of this group recites the steps of “modifying the accessible file name to include an indication of the specified update conditions to form a retrieval file name,” then “combining the retrieval file name with at least the update data to form a back-up retrieval file” and then “saving the back-up retrieval file in a retrieval storage area.” Col. 7, lines 58-60 of Tarabella only teach accessing a library 12 for library images to update images at a user selected time and with a user selected sequence. This is the time noted at col. 7, lines 28-31, see col. 7, line 61-col. 8, line 8. There is no performance of the above-noted steps of Claim 17 and no forming or saving of a back-up retrieval file.

As noted above, the file name suggestion of Kazu relates to providing an original file name, not a backup file name and not something remotely like the image library access of Tarabella that is based on an index. Thus, there is no logical basis presented in the outstanding Action to apply the Kazu teaching to the image library access of Tarabella. Once again, the basic rejection does nothing more than look to incomplete isolated reference teachings and suggest that the artisan might by chance combine them in a manner to encompass the subject matter of base Claim. Accordingly, as no valid *prima facie* case of

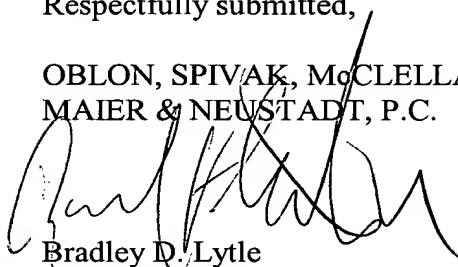
Application No. 09/537,074
Reply to Office Action of 10/10/03

obviousness has been established as to base Claim 17 and as none of Nathan, Tatematsu, or Curtis considered alone or in any proper combination, cure the deficiencies in Tarabella and Kazu noted above, these rejections are also traversed.

As no other issues are believed to remain outstanding relative to this application, it is believed to be clear that this application is in condition for formal allowance and an early and favorable action to this effect is, therefore, respectfully requested.

Respectfully submitted,

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